



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,783	11/28/2001	Francois Girard	P21643	8368
7055	7590	09/08/2004	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/994,783

**Applicant(s)**

GIRARD ET AL.

**Examiner**

Anthony Stashick

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18,20-29,31,32,34-37 and 39-74 is/are pending in the application.
- 4a) Of the above claim(s) 25-29,32,36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18,20-24,31,33-35 and 38-74 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 3728

## DETAILED ACTION

### *Election/Restrictions*

1. Claims 25-29, 32 and 36-38 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7. Therefore, the election is hereby made FINAL.

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5-11, 14-17, 19-24, 31, 34-35, 39-41, 43-46, 48-60, 64-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donnadiou 5,899,006 in view of the Great Britain reference to Sportartikelwerkfabrik Karl Uhl GmbH GB 2,256,784 (GB '784). Donnadiou '006 teaches that a sport shoe for gliding sports can have a front portion and a rear portion with the rear portion more rigid in longitudinal bending than the front portion (see col. 2, lines 28-42) with the front portion being more flexible than the rear portion and the front and rear portion attached to one another in a junction zone (see Figures 1, 2a and 2b) that is adjustable. Donnadiou '006 also teaches that the front portion of the shoe can have at least one element attached to it for coupling to a gliding element (see 6). Donnadiou '006 does not teach the reinforcement member and the qualities that go with the reinforcement member. GB '784 teaches the following: a front portion 71a and a rear portion 71b more rigid in longitudinal bending than the front portion (page 12, line 19-page 13, line 10); at least one reinforcement in said

Art Unit: 3728

two portions 63; the front portion comprises a front half-sole 71a affixed to the reinforcement 63; the rear portion comprises a rear half-sole 71b affixed to the reinforcement 63; the front and rear half-soles are assembled to one another in a junction zone 72; the limit between the flexible front portion and the rigid rear portion is located substantially at the rear of the metatarsophalangeal bending zone (See Figure 2); the junction zone is located in and/or behind the so-called metatarsophalangeal bending zone (see Figure 2); wherein a reinforcement member has at least one laminated plate 72 extending from the junction zone on both the front and rear half-soles; the reinforcement member has a length at least 60% (60%-80%) of the length of the sole (see Figure 2); at least one of the front or rear portions having a construction designed to cooperate with a sports apparatus (the cleat of the shoe); at least one of the front or rear half soles is constituted by at least one piece for guiding and for connecting to a sports shoe apparatus (the receiver for the spike); the sole has, on its lower surface in the front or rear portion at least one guiding member (receiver for spike) adapted to cooperate (threaded) with complementarily shaped guiding support (the threaded stem of the spike) provided on the sports apparatus (the spike); the sole being adapted to be coupled to the sports apparatus (screw in the spike into the receiver); the reinforcement member is assembled to the front and rear portion of the sole by cementing; the reinforcement member is made of a composite (thermoplastic material); the reinforcement member has a sandwich structure (from side-to-side rather than top to bottom); the sandwich structure has a thickness less than 3 mm (see Figures 2-6); the reinforcement member is a plate covered with at least one compatibility layer (thin layer of rubber, see 73 in Figure 4) made by of at least one synthetic film; in the rear portion the reinforcement member has one or several upward extensions 65 and is associated with at least one other reinforcement; the rear portion forms an integral assembly with a stiffener (63) covering the heel; the rear portion having a different rigidity than the stiffener (different material); the portions are made of different materials; the sole is an outer sole see Figures); the sole having at least one recess (that through 65) that shows a portion of the reinforcement; the shoe is a sports boot (see

Art Unit: 3728

page 12, line 19); the sports boot is adapted to be affixed on a sports apparatus (spikes); the sole having a plate 63 to reinforce the sole and corresponding to a planar projection of a human foot (see Figure 1); an upper attached to the sole (see Figure 1); the periphery of the reinforcement member structure is spaced from that of both the front and rear sole portion peripheries (see Figure 7); the reinforcement is made of composite materials (see Abstract of GB '784) more rigid than that of the front and rear portions (therefore, a reinforcement member) and made of a matrix of embedded fibers (see Abstract); members extending down from and molded with the sole portions (see Figure 1); the reinforcement member is positioned above at least parts of the front and rear sole portions (see Figure 7); .

Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a reinforcement member, such as that taught in GB '784 in the boot of Donnadieu '006 to aid in transferring the translational forces of the foot to the shoe to gain better control of the gliding member attached to the boot.

4. Claims 46-47 and 61-63 are rejected under 35 U.S.C. 103 (a) as being unpatentable over the references as applied to claim 43 above in view of Official Notice. The methods of attachment claimed in these claims are well known in the art of shoemaking and appear to be an art accepted equivalent way of attaching the soles together. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to attach the sole together by any means known in the art to hold the sole together.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above in view of Montgomery et al. 4,924,606. GB '784 discloses all the limitations substantially as claimed except for the front and rear portions overlapping in the junction zone. Montgomery et al. '606 teaches that a two part sole can overlap each other when connected together to allow for increasing flexibility of the shoe in this region as well as allow for adaptability to

Art Unit: 3728

many different sizes. Therefore, it would have been obvious, in view of Montgomery et al. '606, to make the front and rear portions of the sole of the references as applied to claim 1 above overlap in the junction zone to allow for better flexibility of the sole and adjustability of the sole to shoes of different sizes.

#### ***Allowable Subject Matter***

6. Claims 12, 13, 18 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 49-59 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

#### ***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Applicant's request for rejoinder of the withdrawn claims cannot be allowed because there is no generic claim allowed, as required.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday through Thursday from 6:30 am until 4:00 pm.

Art Unit: 3728

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS